

### **REMARKS/ARGUMENTS**

Reconsideration of this Application and entry of this Amendment is respectfully requested. By the amendments, Applicants do not acquiesce to the propriety of any of the Office's rejections and do not disclaim any subject matter to which Applicants are entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997).

No new matter has been added as a result of the present amendments.

#### **In the Claims**

Claims 1-12, 14-16 and 24-26 are pending in this application. Claim 10 has been previously withdrawn from consideration. Claims 13 and 17-23 have been previously cancelled. In view of the Examiner's earlier restriction requirement, Applicants retain the right to present claim 10 in a divisional application.

Solely in an effort to expedite prosecution of the present case and not to acquiesce to the Office's rejections, claims 1, 16 and 24 have been amended to define R1 and R2 as hydrogen. Support can be found, for example in claim 4, which has been amended to remove such limitations. Claim 1 has further been amended to recite "wherein at least one of R3, R4, R5, R6, R7, R8, R9, R10 and R11 is a linker and the linker joins the therapeutic component and the efficacy enhancing component."

Claims 9 and 11 have been cancelled.

#### **35 U.S.C. §102 Rejections**

Claims 1, 7, 9 and 16 are rejected under 35 U.S.C. §102(b) as being anticipated by Collins et al. (WO 01/92288, herein after "Collins"). The Office asserts that Collins discloses compositions which are embraced by the instant claimed invention. The Applicants respectfully disagree.

As the Office is aware, a claim is anticipated under 35 U.S.C. §102 only if each and every element as set forth in a claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131; *Verdegaal Bros. V. Union Oil*

*Co. of California*, 814 F.2d, 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). A claimed invention is anticipated only when it is “known to the art in the detail of the claim.” *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). In other words, not only must the limitations of the claim be shown in a single prior art reference, the limitations must be “arranged as in the claim.” *Id.*

The Applicants assert that Collins does not teach a pharmaceutical conjugate comprising a therapeutic component covalently coupled to an efficacy enhancing component as presently claimed. The presently amended claims teach an adamantane amine efficacy enhancing component linked to a therapeutic component at a position other than at the amine.

In contrast, Collins teaches that antibiotics that contain an amine or amide group “can be linked to the TC- of IF-binding agent through that functional moiety, using standard reactions for covalent bond formation to a nitrogen atom” (Page 85, lines 3-5). As such, the adamantane HCl listed on Page 92, as pointed out by the Office, is covalently bonded to the TC- of IF-binding agent through the amine group, not at another location as is presently claimed.

In light of the above, Collins does not teach the compositions presently claimed, and therefore, fails to teach each and every element of the presently amended claims. As such, the Applicants request reconsideration of claims 1, 7, 9 and 16 as amended.

### **35 U.S.C. §103 Rejections**

Claims 1-6, 7, 8, 9, 11-12, 14-16 and 24-26 are rejected under 35 U.S.C. §103(a) as being obvious over Desantis, Jr. (US 2001-0047012, hereinafter “Desantis”) in view of Collins. The Office suggests that Desantis teaches combination therapy and Collins teaches pharmaceutical conjugates comprising a bioactive agent that is covalently bound to a linker. The Applicants respectfully disagree.

To maintain a proper rejection under 35 U.S.C. §103, the Office must meet four conditions to establish a *prima facie* case of obviousness. First, the Office must show that the prior art suggested to those of ordinary skill in the art that they should make the

claimed composition or device or carry out the claimed process. Second, the Office must show that the prior art would have provided one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in an applicant's disclosure. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Fourth, if an obviousness rejection is based on some combination of prior art references, the Office must show a suggestion, teaching, or motivation to combine the prior art references ("the TSM test"). *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Following *KSR Int'l Co. v. Teleflex, Inc.*, this fourth prong of the *prima facie* obviousness analysis must not be applied in a rigid or formulaic way such that it becomes inconsistent with the more flexible approach of *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966); 127 S. Ct. 1727 (2007). It must still be applied, however, as the TSM test captures the important insight that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at 1741 (citing *United States v. Adams*, 383 U.S. 39, 50-52 (1966)).

As discussed above, Collins does not teach a pharmaceutical conjugate comprising a therapeutic component covalently coupled to an efficacy enhancing component as presently claimed. The presently amended claims teach an adamantane amine efficacy enhancing component linked to a therapeutic component at a position other than the amine.

In contrast, Collins teaches that antibiotics that contain an amine or amide group that "can be linked to the TC- of IF-binding agent through that functional moiety, using standard reactions for covalent bond formation to a nitrogen atom" (Page 85, lines 3-5). As such, the adamantane HCl listed on Page 92, as pointed out by the Office, is covalently bonded to the TC- of IF-binding agent through the amine group, not at another location as presently claimed.

The Office attempts to combine the teachings of Collins with those of Desantis which teaches methods of treating glaucoma using combination therapy. Desantis'

combination therapy requires the “use of a glutatmate anatagonist and an IOP controlling agent, dosed separately or in combination for the treatment of persons suffering from glaucoma or ocular hypertension.” (paragraph [0006]). Desantis does not teach a glutatmate anatagonist covalently linked to an IOP controlling agent as presently claimed. As such, this teaching does not remedy the deficiency of Collins.

Therefore, the combination of a glutatmate anatagonist and an IOP controlling agent and Collins does not teach an adamantine amine efficacy enhancing component linked to a therapeutic component at a position other than at the amine as presently claimed. In light of the above, the Applicants assert that a proper *prima facie* case of obviousness has not been established with regard to claims 1-6, 7, 8, 9, 11-12, 14-16 and 24-26 as amended. Therefore, the Applicants request withdrawal of the rejection under 35 U.S.C. §103(a) and allowance of the application.

### **Conclusion**

Applicants respectfully request that a timely Notice of Allowance be issued in this case. The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 01-0885.

Respectfully submitted,

Dated: October 5, 2009

/John E. Wurst/

Registration No. 40,283  
CUSTOMER NUMBER: 051957

John Wurst (T2-7H)  
Allergan, Inc.  
2525 Dupont Drive  
Irvine, CA 92612  
Tel: 714.246.5475  
Fax: 714.246.4249